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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,104	01/14/2002	David J. Corisis	M4065.0317/P317-B	7226
24998	7590	10/27/2003	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			ESTRADA, MICHELLE	
2101 L STREET NW			ART UNIT	
WASHINGTON, DC 20037-1526			PAPER NUMBER	

2823

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/043,104	<b>Applicant(s)</b> CORISIS, DAVID J.	
	<b>Examiner</b> Michelle Estrada	<b>Art Unit</b> 2823	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-21 is/are pending in the application.
- 4a) Of the above claim(s) 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                             | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1/14/02</u> | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I (claims 12-18) in Paper filed 09/26/03 is acknowledged. The traversal is on the ground(s) that the claims of Group I and II are closely related and that search and examination of the claims now in the application can be made without serious burden. This is not found persuasive because the Examiner found a reasonable reason of making restriction between the two groups. Because these inventions are distinct for the reasons given in the Office Action mailed 8/26/03 and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaoka (JP 10-064854).

Yamaoka discloses a substrate (64) having an upper surface, a lower surface, and an edge region disposed between said upper and lower surfaces, said edge

including a first cut portion and a second broken portion (See fig. 7); wherein said cut portion further comprises a sawn portion (See Abstract).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka as applied to claims 12 and 13 above, and further in view of Nishino et al. (6,010,384).

Yamaoka does not disclose wherein said cut portion further comprises a scribed portion.

Nishino et al. disclose wherein said cut portion further comprises a scribed portion (Col. 1, lines 40-44).

It would have been within the scope of one of ordinary skill in the art to combine the teachings of Yamaoka and Nishino et al. to enable formation of the cut portion.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka as applied to claims 12 and 13 above, and further in view of Yamada et al. (2001/0005599).

Yamaoka does not disclose wherein said cut portion further comprises a chemically etched portion.

Yamada et al. disclose wherein said cut portion further comprises a chemically etched portion (See Abstract).

It would have been within the scope of one of ordinary skill in the art to combine the teachings of Yamaoka and Yamada et al. to enable formation of the cut portion.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka as applied to claims 12 and 13 above, and further in view of Wakashima et al. (6,492,203).

Yamaoka does not disclose wherein said cut portion further comprises a milled portion.

Wakashima et al. disclose wherein said cut portion further comprises a milled portion (Col. 32, lines 18-20).

It would have been within the scope of one of ordinary skill in the art to combine the teachings of Yamaoka and Wakashima et al. to enable formation of the cut portion.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka as applied to claims 12 and 13 above, and further in view of Huemoeller et al. (6,534,391).

Yamaoka et al. do not disclose wherein said broken portion further comprises a punched portion.

Huemoeller et al. disclose wherein said broken portion further comprises a punched portion (Col. 5, lines 62-64).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaoka as applied to claims 12 and 13 above, and further in view of Itai et al. (5,838,069).


Yamaoka et al. do not disclose wherein said broken portion further comprises a sheared portion.

Itai et al. disclose wherein said broken portion further comprises a sheared portion (Col. 2, lines 20-24 and 41-48).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Estrada whose telephone number is (703) 308-0729. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on 703-306-2794. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

  
George Fourson  
Primary Examiner  
Art Unit 2823

  
MEstrada  
October 16, 2003